

REMARKS / ARGUMENTS

The present application includes pending claims 1-24, all of which have been rejected. By this Amendment, claims 1-10, 12-13, 17-22, and 24 have been amended, as set forth above, to further clarify the language used in these claims and to further prosecution of the present application. The Applicant respectfully submits that the claims define patentable subject matter.

Initially, the Applicant notes that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the *initial review* of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, Office personnel *should* state *all* reasons and bases for rejecting claims in the *first* Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, Office personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

See Manual of Patent Examining Procedure (MPEP) § 2106(II). As such, the Applicant assumes, based on the goals of patent examination noted above, that the present Office Action has set forth “all reasons and bases” for rejecting the claims.

Claims 1-2, 7, 10-13, 18, and 24 stand rejected under 35 U.S.C. § 102(e) as being anticipated by US Patent Publication No. 2004/0032869, issued to Ambe, et al. (hereinafter, Ambe). Claims 3-6, 8-9, 14-17, and 19-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ambe, in view of U.S. Patent No. 7,076,568, issued to Philbrick, et al. (hereinafter, Philbrick). The Applicant respectfully traverses

these rejections at least for the reasons previously set forth during prosecution and the following remarks:

REJECTION UNDER 35 U.S.C. § 102

I. Ambe Does Not Anticipate Claims 1-2, 7, 10-13, 18, and 24

The Applicant first turns to the rejection of claims 1-10, 12-13, 17-22, and 24 under 35 U.S.C. 102(e) as being anticipated by Ambe. With regard to the anticipation rejections under 102(e), MPEP 2131 states that “[a] claim is anticipated only if **each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.**” See Manual of Patent Examining Procedure (MPEP) at 2131 (internal citation omitted). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” See id. (internal citation omitted).

A. Rejection of Independent Claim 1 under 35 U.S.C. § 102 (e)

With regard to the rejection of independent claim 1 under Ambe, the Applicant submits that Ambe does not disclose or suggest at least the limitation of “comparing said destination port bit map with a physical port security bit map to generate a bit map of allowed destination ports, **wherein said physical port security bit map is generated based on information in said received frame of digital data,**” as recited by the Applicant in independent claim 1 (emphasis added).

The Office Action states the following:

Ambe teaches ... comparing said destination port bit map with a physical port security bit map to generate a bit map of allowed destination ports (see figure 2, element 150 'comparing the ingress port bit map with at least one ingress port match entry'; and page 3, paragraph [0027] of Ambe).

See the Office Action at page 2. Initially, the Applicant points out that Ambe does not disclose or suggest generating a physical port security bitmap, as recited in claim 1. Furthermore, step 150 in Figure 2 of Ambe discloses comparing of an "ingress port bit map" with an "ingress port match entry". Apparently, the Examiner is equating the "ingress port match entry" with the physical port security bit map recited in Applicant's claim 1. The Applicant respectfully disagrees. Ambe discloses packet filtering based on a pre-determined rules table 70, within the filter 20. In this regard, the "ingress port match entry" of Ambe is determined using an entry from the table 70 and not by using information within the received digital data frame.

Therefore, Ambe does not disclose or suggest at least the limitation of "comparing said destination port bit map with a physical port security bit map to generate a bit map of allowed destination ports, wherein said physical port security bit map is generated based on information in said received frame of digital data," as recited by the Applicant in independent claim 1. Accordingly, independent claim 1 is not anticipated by Ambe and is allowable. Independent claim 12 is similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claim 12 is also allowable over Ambe at least for the reasons stated above with regard to claim 1.

B. Rejection of Dependent Claims 2, 7, 10-11, 13, 18, and 24

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1 and 12 under 35 U.S.C. § 102(e) as being anticipated by Ambe has been overcome and request that the rejection be withdrawn. Additionally, claims 2, 7, 10-11 depend from claim 1 and claims 13, 18, and 24 depend from claim 12. Therefore, claims 2, 7, 10-11, 13, 18, and 24 are also respectfully submitted to be allowable at least for the above reasons.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 1-2, 7, 10-13, 18, and 24.

REJECTION UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure ("MPEP") states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

See MPEP at § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless

the prior art suggests the desirability of the combination," and that "although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a *suggestion or motivation in the reference to do so*" (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Moreover, MPEP § 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion...," citing *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

II. Rejection of Dependent Claims 3-6, 8-9, 14-17, and 19-23

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1 and 12 under 35 U.S.C. § 102(e) has been overcome and requests that the rejection be withdrawn. Additionally, since the additional cited reference (Philbrick) does not overcome the deficiencies of Ambe, claims 3-6, 8-9 (depending from claim 1) and claims 14-17 and 19-23 (depending from claim 12), are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 3-6, 8-9, 14-17, and 19-23.

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CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 1-24 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and request that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

Ognyan Beremski, Esq.
Registration No. 51,458
Attorney for Applicant

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McANDREWS, HELD & MALLOY, LTD.
500 WEST MADISON STREET, 34TH FLOOR
CHICAGO, ILLINOIS 60661
(312) 775-8000

/OIB